

### **REMARKS/ARGUMENTS**

This amendment is in response to an Office Action mailed July 27, 2004. Claims 1, 13, 41 and 48 have been amended and Applicant respectfully requests reconsideration of all pending claims.

#### **Rejection Under 35 U.S.C. § 103**

Claims 1, 3, 4-8, 13, 16-23, 34, 35, 37-50 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Barwick (U.S. Patent No. 5,700,240) in view of Peterson (WO 93/18802). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP §2143*. Herein, besides a lack of motivation to combine, the combined teachings of Barwick and Peterson fail to teach or suggest all of the claim limitations.

#### **A. LACK OF MOTIVATION**

First, the Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. For instance, in *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q 929, 933 (Fed. Cir. 1984), the Federal Circuit stated “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” There is no motivation for the combination suggested by the Examiner.

Peterson is directed to an accumulator while Barwick teaches two irrigation fluid sources (32, 33) connected to a valve (35). The valve (35) functions to *alternatively* connect line (32a) and source (32) and line (33a) and source (33) with the handpiece. Emphasis added; See

Column 6, lines 40-43 of Barwick. There is no motivation or suggestion to substitute the irrigation fluid source (32 or 33) of Barwick with an accumulator (3) of Peterson because the irrigation fluid sources are not designed to provide any feedback to the computer.

**B. LACK OF TEACHING/SUGGESTING ALL OF THE CLAIM LIMITATIONS**

With respect to independent claims 1 and 48, Applicant respectfully submit that neither Barwick nor Peterson, alone or in combination, suggest to operate as a secondary fluid source without adjustment of a valve, which is now claimed. It is noted that the valve (35) of Barwick functions to *alternatively* supply fluid from irrigation fluid sources (32 and 33). *Emphasis added*. The substitution of an accumulator, even if considered by the Examiner to be suggested by the cited references, would not supply fluid in response to reduced speed of said pump without adjustment of the valve (35). This is based on the alternative selection of the irrigation fluid sources (32, 33) of Barwick.

Hence, claims 1 and 48, as well as those claims dependent thereon, are in condition for allowance.

With respect to independent claims 37 and 41, Applicant respectfully submit that neither Barwick nor Peterson, alone or in combination, suggest that the accumulator provides pressurized fluid from a first chamber to the irrigation line in addition to the fluid supplied by the fluid reservoir or other fluid. In fact, the combined teachings of Barwick and Peterson, even if deemed to be suggested, teaches away from dual sources supplying fluid. Barwick explicitly teaches that the valve “functions to alternatively connect line 32a and source 32 and line 33a and source 33 with the handpiece 30.” *See Column 6, lines 40-41 of Barwick*. Hence, claims 37 and 41, as well as those claims dependent thereon, are in condition for allowance.

With respect to independent claim 13, Applicant respectfully submit that neither Barwick nor Peterson, alone or in combination, suggest that the accumulator is *directly* coupled to the same irrigation line to which the irrigation reservoir is coupled. This limitation is not taught nor suggested by that combined teachings of Barwick and Peterson. Hence, independent claim 13 and those claims dependent thereon are in condition for allowance.

CONCLUSION

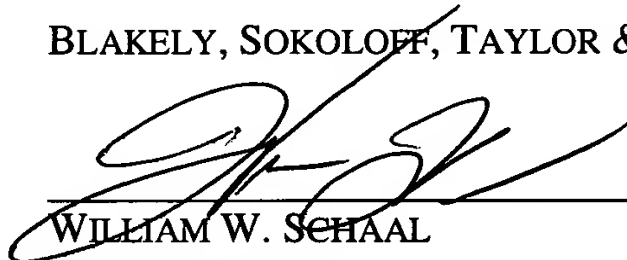
In view of the foregoing, Applicant contends that a prima facie case of obviousness has not been established and respectfully requests the Examiner to allow all of the pending claims. Allowance of these claims at Examiner's earliest convenience is respectfully solicited.

In order to further facilitate prosecution of the subject application, Applicants respectfully request the Examiner to contact the undersigned attorney at the phone number listed below to coordinate an Examiner's interview to discuss the allowability of the pending claims if such discussion is warranted. The undersigned attorney can be reached at the phone number listed below.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 27, 2005

  
\_\_\_\_\_  
WILLIAM W. SCHAAL  
Reg. No. 39,018

---

**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)**

*I hereby certify that this correspondence is, on the date shown below, being:*

**MAILING**

☒ deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, PO Box 1450,  
Alexandria, VA 22313-1450.

Date: January 27, 2005

**FACSIMILE**

☐ transmitted by facsimile to the Patent and  
Trademark Office.

\_\_\_\_\_  
Tu Nguyen  January 27, 2005  
Date